

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Alan S. Fisher et al.	Examiner:	Olabode Akintola
Serial No.:	09/706,849	Group Art Unit:	3691
Filed:	November 7, 2000	Docket No.:	2043.086US2
Customer No.:	49845	Confirmation No.:	8858
Title:	METHOD AND SYSTEM FOR PROCESSING AND TRANSMITTING ELECTRONIC AUCTION INFORMATION		

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This reply is presented in response to the Examiner's Answer, dated February 2, 2011, which was sent in response to Appellants' Appeal Brief, filed on December 1, 2010. Appellants have reviewed the Answer and believe that the statements in the original Appeal Brief remain accurate and compelling. Further, Appellants submit the following remarks in response to the Examiner's comments presented beginning on page 9 of the Answer.

35 U.S.C. § 112, First ParagraphClaims 26-30, 32-39, 41-48, and 50-52

With respect to independent claims 26, 35, and 44, the Answer asserts that "bid validation with reference to the current high bid is not explicitly recited in the specification," and that "bid validation can be done with reference to or in view of any parameter." First, as Appellants have previously asserted, explicit recitation of a claim limitation is not required in the specification provided that one of ordinary skill in the art would recognize that the inventor(s) have invented what is claimed. As Appellants stated in the Appeal Brief, the "objective standard for determining compliance with the written description requirement is, 'does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.'"¹ Further, the "subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description

¹ MPEP § 2163.02, citing *In re Gosteli*, 872 F.2d 1008, 1012, 10 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1989).

requirement.”² Appellants have set forth their reasons in the Appeal Brief as to why one of ordinary skill in the art would be informed by the specification that a bid is validated to ensure a bid amount is credible in view of a current high bid. Appellants submit their proffered arguments meet the objective standard for determining compliance with the written description requirement.

Furthermore, the Answer’s stated response to Appellants’ arguments is wholly irrelevant and fails to address the § 112, first paragraph, rejection. Beyond a conclusory statement that the specification does not support the limitation in question, the Answer offers no reason or analysis as to why the portions of the specification cited by Appellants fail to provide written description support for the rejected limitations of claims 26, 35, and 44. *See* Examiner’s Answer of February 2, 2011, p. 10. Instead, the Answer states that bid validation can be done “with reference to or in view of any parameter.” *Id.* This statement and the subsequently offered examples fail to address or refute Appellants’ arguments. That bid validation can be done “with reference to or in view of any parameter” does not mean that bid validation with reference to a current high bid is not supported by the specification, yet the Answer fails to offer any citation to the specification showing which “parameters” are disclosed and which “parameters” are not disclosed. *Id.* Thus, Appellants submit the specification provides written description support for the limitation “validate the bid to ensure that the bid amount is credible in view of a current high bid,” recited in claims 26, 35, and 44 for the reasons specified herein and in the Appeal Brief, and further submit that these reasons are not negated by the Answer.

35 U.S.C. § 112, Second Paragraph

Claims 44-48 and 50-52

With respect to the § 112, second paragraph, rejection of claims 44-48 and 50-52, Appellants note that it appears the Examiner is confusing the appealed § 112, second paragraph, rejection of claims 44-48 and 50-52 on the grounds of indefiniteness with a § 112, first paragraph, rejection on the grounds of inadequate written description support. The Final Office Action mailed March 1, 2010 rejected claims 44-48 and 50-52 on a § 112, second paragraph, basis. Appellants addressed the § 112, second paragraph, rejection in the Appeal Brief. *See,*

² MPEP § 2163.02.

e.g., Appeal Brief of December 1, 2010, pp. 10 and 13-14. Now, it appears the Answer is addressing a previously unasserted § 112, first paragraph, rejection of claims 44-48 and 50-52.

For the reasons stated in the Appeal Brief, Appellants respectfully submit that the auction manager of claims 44-48 and 50-52 is definite and further submit that these reasons are not negated by the Answer.

Further, in the event the Answer is alleging a new ground of rejection (*i.e.*, § 112, first paragraph), Appellants note that the specification clearly provides written description support for the auction manager querying a database to automatically determine whether the bid is successful or unsuccessful. For example, the specification states that the “[a]uction manager 26 preferably frequently queries the bid database to see if any new bids have been placed. If new bids are found during the query, then auction manager 26 calculates the current high bidder or bidders and instructs merchandise catalog page generator 25 to regenerate a catalog page with the updated bid information.” *See, e.g.*, Specification, p. 15, lines 9-14. Thus, even if the Answer asserts a new ground of rejection under 35 U.S.C. § 112, first paragraph, for claims 44-48 and 50-52, Appellants submit this rejection is unfounded and should be withdrawn in light of the clear support in the specification for the “auction manager” limitation.

35 U.S.C. § 103(a)

With respect to the § 103(a) rejection of claims 26-27, 30, 33, 35-36, 39, 41-42, 44-45, 48, and 50-51, Appellants presented arguments in the Appeal Brief that Woolston in view of Fraser and further in view of Philips failed to disclose or suggest the claim limitation “add a second lot to the plurality of lots during an auction of the first lot of the plurality of lots by posting on the computerized merchandise catalog information that is descriptive of items in the second lot, wherein the information pertaining to the second lot is added to the merchandise catalog as at least a portion of the first lot of the plurality of lots is made available for auction,” as recited in independent claims 26, 35, and 44.

In response, the Answer states that the claim language “wherein the information pertaining to the second lot is added to the merchandise catalog as at least a portion of the first lot of the plurality of lots is made available for auction,” as recited in independent claims 26, 35, and 44, “is not commensurate in scope” with the portions of the specification cited by the Appellants in support of the claim language in the Appeal Brief. The Answer then applies its

own interpretation to the claim and alleges Woolston teaches the Answer's interpretation of the claim.

Interestingly, the Answer does not dispute that if the claim language at issue is commensurate with the specification, Woolston and the other cited references do not teach or suggest every element of claims 26, 35, and 44.

Appellants note the portions of the specification supporting this claim limitation in the Appeal Brief are non-limiting portions of the specification cited as examples (as denoted by the use of the language "*see, e.g.*"). *See* Appeal Brief of December 1, 2010, p. 6. The Examiner is unduly limiting the scope of the claims based on the example portions of the specification that support the claim language.

In any event, Appellants note that the portions of the specification cited as supporting this claim limitation are commensurate with the scope of the claim. For example, the specification discloses that an auction manager is a *continuously running* system that checks to see if any new items for sale are to be opened by examining a merchandise database to see if any new merchandise items are scheduled to be made available for bidding by customers at or before a current time. *See* Specification, p. 16, lines 20-25. If new items are scheduled for posting, the items are opened for bidding. *See* Specification, p. 17, lines 1-2. The auction manager then examines the merchandise database to see if any merchandise items are scheduled to be closed from customer bidding. *See* Specification, p. 17, lines 3-4. If items are scheduled to be closed, the items are closed from bidding. *See* Specification. P. 17, lines 4-5. The checking of new items to post and existing items to close is a continual process performed by the continuously running auction manager.

To interpret the specification, including the above-recited portions, as disclosing only an auction manager that opens items for bidding and closes items from bidding, as the Examiner has done, is to take an improperly narrow view of the teachings of the specification. Disclosure may take the form of an explicit, inherent, or implied teaching. MPEP § 2106. Further, the pending claims must be given their broadest reasonable interpretation consistent with the specification. MPEP § 2111. In this case, the specification discloses that, at any given point in time, various items are open for bidding and a *continuously running auction manager system posts new items for bidding and closes existing items from bidding as the scheduled times for opening and closing bidding occur*. It naturally follows that items may be currently open for bidding

when a new item is posted for bidding, and that the continuously running auction manager would post a new item for bidding while other items are currently open for bidding. One of ordinary skill in the art would certainly appreciate that the specification explicitly, inherently, or implicitly teaches this. Thus, the specification explicitly supports or, at the very least, clearly implies, that the claim limitation “wherein the information pertaining to the second lot is added to the merchandise catalog as at least a portion of the first lot of the plurality of lots is made available for auction.”

Accordingly, Appellants respectfully submit the Answer’s interpretation of the claim language and specification is unduly narrow and unsupported by the teachings of the specification. Based on a proper reading of the claim, the cited prior art (Woolston in view of Fraser and further in view of Philips) does not disclose or suggest every element of the pending claims. Appellants respectfully request the § 103(a) rejection be reversed and claims 26-27, 30, 33, 35-36, 39, 41-42, 44-45, 48, and 50-51 be allowed.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (408) 278-4056 to facilitate prosecution of this application.

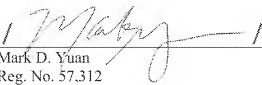
If necessary, please charge any additional fees or credit overpayment to Deposit Account 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4 day of April, 2011.

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